



Express Mail: EV 533 735 635 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Bravo Vasquez and Hill Confirmation No.: 9071
Patent No.: 6,777,036 Art Unit: 1762
Issued: August 17, 2004
Application No.: 09/876,944 Examiner: Padgett, Marianne.
Filed: June 8, 2001

For: METHOD FOR THE DEPOSITION OF Attorney Docket No.: 60937-0120
MATERIALS FROM
MESOMORPHOUS FILMS

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request reconsideration of the Patent Term Adjustment of the above-identified U.S. Patent under 37 CFR 1.705(d), as amended (see *Official Gazette*, 1281 OG 100, April 22, 2004). Under § 1.705(d) a patentee may request reconsideration of Patent Term Adjustment (PTA) within 2 months of issuance if the patent indicates a revised PTA relative to the PTA indicated on the Notice of Allowance (form PTOL-85 "Determination of Patent Term Adjustment under 35 U.S.C. § 154(b)").

In the present matter, the Form PTOL-85 (a copy of which is attached hereto) indicated the PTA would be 121 days. However, the patent (a copy of the face page of which is attached hereto) indicates a revised PTA of 56 days. Because Applicants did not take any action that would result in such a reduction, Applicants hereby request reconsideration of the PTA of 56 days in connection with the above-identified U.S. Patent.

Statement of Facts

The Notice of Allowance (form PTOL-85), mailed May 3, 2004, stated that the Patent Term Adjustment (PTA) would be 121 days. Applicants timely paid the issue fee, June 14,

2004. Applicants filed no other paper after receipt of the Notice of Allowance that falls into any of the categories of 37 C.F.R. § 1.704(c).

The Issue Notification, mailed July 29, 2004, indicated that the PTA is only 56 days (representing a reduction of 65 days from that indicated on the Notice of Allowance). Applicants see no grounds for such reduction, and hereby respectfully request reconsideration thereof, and reinstatement of the full PTA of 121 days indicated on the Notice of Allowance.

The undersigned spoke with Karin Ferriter in the Office of Patent Legal Administration on September 10, 2004 in connection with the reduction in the PTA. Ms. Ferriter checked the PTO electronic records for the subject application. She stated that the probable reason for the reduction in the PTA was a “miscellaneous communication” mailed June 14, 2004, because entry of any item designated as a “miscellaneous communication” after a notice of allowance would automatically trigger a reduction of PTA under 37 CFR § 1.703(c). Ms. Ferriter was unable to determine the nature of the miscellaneous communication. She suggested that it could either be the Comments on Statements of Reasons for Allowance, or the undersigned’s Certificate of Limited Recognition under 37 C.F.R. § 10.9(b), both mailed June 14, 2004 concurrently with payment of the issue fee.

Ms. Ferriter stated that the paper, Comments on Statements of Reasons for Allowance, mailed by Applicants on June 14, 2004, should ordinarily be entered in the system as “RES” (for response), and not as a miscellaneous communication. No paper had been entered as “RES”. If the Comments on Statements of Reasons for Allowance had been entered as “RES”, then a reduction in PTA would probably not have arisen in connection therewith. Accordingly, Applicants respectfully submit that the Comments on Statements of Reasons for Allowance should not trigger a reduction in PTA.

Furthermore, the undersigned’s Certificate of Limited Recognition under 37 C.F.R. 10.9(b) is simply a certification of the undersigned’s authority to practice before the Office in the subject matter and therefore also is not a communication within the definition of 37 CFR § 1.703(c). Accordingly this paper should also not trigger a reduction in PTA.

Applicants are otherwise unaware of any “miscellaneous communication” dated June 14, 2004, and their file contains no such miscellaneous communication dated June 14, 2004. Accordingly, Applicants respectfully seek reinstatement of the full Patent Term Adjustment of 121 days in the subject patent.

Applicants assert that the subject U.S. patent is not subject to a terminal disclaimer, and that Applicants did not fail to engage in reasonable efforts to conclude processing of the application after receipt of the Notice of Allowance, mailed May 3, 2004.

Under the provisions of 37 C.F.R. § 1.705(d) as amended, Applicants timely submit this request for reconsideration on the day that is the first business day after the date that is 2 months after the issue of the above-identified U.S. Patent.

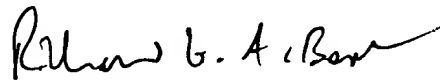
Fee Authorization

Applicants believe that the reduction in patent term adjustment was a result of PTO error, and, therefore, that no fee is owed with this request. Nevertheless, in compliance with 37 C.F.R. § 1.705(b)(1), Applicants hereby authorize payment of the fee of \$200.00, under 37 C.F.R. § 1.18(e). No other fee is believed due with this response. However, should the Commissioner determine otherwise, he is authorized to charge any additional fee(s) associated with this communication or to credit any overpayment to our deposit account number 50-0310 (order no. 60937-0120). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

October 18, 2004

Date



Richard G. A. Bone
Limited Recognition Under 37 C.F.R. § 10.9(b)
(Copy of Certificate attached hereto)

for James S. McDonald, Reg. No. 44,229
MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, California 94306
Tel. (650) 843-4000



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,944	06/08/2001	Juan Pablo Bravo Vasquez	8317-120-999	9071

24341 7590 05/03/2004
MORGAN, LEWIS & BOCKIUS, LLP.
3300 HILLVIEW AVENUE
PALO ALTO, CA 94304

EXAMINER

PADGETT, MARIANNE L

ART UNIT PAPER NUMBER

1762

DATE MAILED: 05/03/2004

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 121 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 121 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

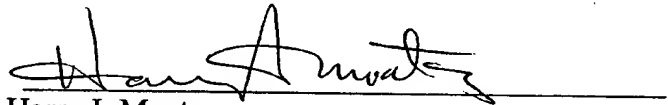
**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATES PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Dr. Richard G. A. Bone is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Morgan, Lewis & Bockius LLP to prepare and prosecute patent applications wherein the patent applicant is the client of Morgan, Lewis & Bockius LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Morgan, Lewis & Bockius LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Dr. Richard G. A. Bone ceases to lawfully reside in the United States, (ii) Dr. Richard G. A. Bone's employment with Morgan, Lewis & Bockius LLP ceases or is terminated, or (iii) Dr. Richard G. A. Bone's current Employment Authorization card expires.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: November 11, 2004

A handwritten signature in black ink, appearing to read "Harry I. Moatz", is written over a horizontal line.

Harry I. Moatz
Director of Enrollment and Discipline